

REMARKS

Claims 1, 11 and 22 are Allowable

The Office has rejected claims 1, 11 and 22 as unpatentable for failure to comply with the requirements of 35 U.S.C. §112, first paragraph.

The Office takes the position that the specification lacks support for the language "...and the attempted transaction is processed without providing the notification message when the attempted transaction does not satisfy the threshold-based rule". The Office takes the position that support for the quoted language is not found at paragraphs 0032 and 0033 of the specification.

The Applicants respectfully traverse this ground for rejection.

The claims must be read in light of the specification as a whole. Generally, the specification discloses a system which provides for notification of payment card transactions to a payment card holder. As described in paragraph 0032, one embodiment of the described transaction notification system applies threshold-based rules for the notification. In such an embodiment, notification is given "when the attempted transaction satisfies a threshold-based rule". The rejected claim language simply states the inverse—which is inherent in the disclosure— if the threshold-based rule is not satisfied, the transaction is processed without providing a notification message.

Thus, the Applicants respectfully submit that claims 1, 11 and 22, as presented, fully meet the requirements of 35 U.S.C. §112, first paragraph.

Claims 1, 2, 6, 9-12, 16, 19, 20 and 23-32 are Allowable

The Office has rejected claims 1, 2, 6, 9-12, 16, 19, 20 and 23-32 under 35 U.S.C. §103(a) as obvious over Brown et al. in view of Ramsey-Catan.

The Applicants respectfully traverse the rejection.

The Office previously had rejected certain of these claims based under 35 U.S.C. §102 as anticipated by Brown. The Office now rejects these claims based on a combination of Brown with Ramsey-Catan, admitting, “Brown lacks the teaching of approving the attempted transaction without providing the notification message.” The above feature is recited in the independent claims. Thus, the Office admits that Brown fails to disclose each element of claim 1.

The Office takes the position that Ramsey-Catan, in combination with Brown, overcomes the deficiency of Brown and states that “Ramsey-Catan teaches an attempted transaction approved without providing a notification message when the attempted transaction does not satisfy a threshold-based rule.” Applicants disagree.

As a threshold issue, the Office has not made a prima facie argument that the Brown reference and the Ramsey-Catan reference are combinable for purposes of showing obviousness under 35 U.S.C. §103. Further, even if the teachings are combined, there is no showing that the combination would lead to the claimed invention of claims 1 or 11.

Brown is directed to the “detection of unauthorized account transactions” (see Brown at the title); Ramsey-Catan, on the other hand, is directed to a “TV shopping monitor and notification system” (see Ramsey-Catan at the title).

More particularly, the cited portions of Brown are directed to confirming whether a personal identification number (PIN) is input correctly and, if it was, providing information to the account holder regarding the transaction (the Office has cited to Brown at paragraph 0037.)

The Office has not pointed to any particular teaching of Ramsey-Catan to support the conclusion that Ramsey-Catan teaches an attempted transaction being approved without providing a notification message when the attempted transaction does not satisfy a threshold-based rule.

However, it is noteworthy that Ramsey-Catan is clearly directed to a system for tracking and control of transactions purchased through a television based shopping system where the various checks against pre-set limits are done by the television based shopping system before the transaction is even provided to a credit card or other payment card processor (see, e.g., Ramsey-Catan at paragraph 0027).

For at least this reason, there is no showing that a combination of the teachings of the cited combination of Brown and Ramsey-Catan discloses or suggests the particular combination

of claim 1 or claim 11 would lead to the claimed invention. Rather, the teachings of Ramsey-Catan would suggest that the retailer or other entity seeking to sell a product or service to the payment card holder would have its own database of customers and their preset limits and the system would check against that database before sending a transaction to be processed by a payment card processor.

For this at least reason, claims 1, 2, 6, 9-12, 16, 19, 20 and 23-32 are allowable over the cited combination.

Claims 3 and 13 are Allowable

The Office has rejected claims 3 and 13 under 35 U.S.C. §103(a) as obvious over Brown/Ramsey-Catan in view of Walker.

Without admitting that Brown, Ramsey-Catan and Walker are properly combinable in making this rejection, or that the teachings of Walker, if combined with Brown and Ramsey-Catan, would show the invention as claimed in claims 1 or 11, claims 3 and 13 depend from Claims 1 and 11, respectively, and are allowable for reasons as discussed above in connection with those claims.

Claims 5, 15 and 22 are Allowable

The Office has rejected claims 5, 15 and 22 under 35 U.S.C. §103(a) as obvious over Brown/Ramsey-Catan in view of Gopinathan.

Without admitting that Brown, Ramsey-Catan and Gopinathan are properly combinable in making this rejection, or that the teachings of Gopinathan, if combined with Brown and Ramsey-Catan, would show the invention as claimed in claims 1 and 11, claims 5 and 15 depend from Claims 1, and 11, respectively, and are allowable for reasons as discussed above in connection with those claims.

With respect to independent claim 22, the Office previously had rejected claim 22 under 35 U.S.C. §102 as anticipated by Brown. The Office now rejects claim 22 based on a combination of Brown with Ramsey-Catan, admitting, "Brown lacks the teaching of approving the attempted transaction without providing the notification message." The above feature is

recited in claim 22. Thus, the Office admits that Brown fails to disclose each element of claim 22.

The Office takes the position that Ramsey-Catan, in combination with Brown, overcomes the deficiency of Brown and states that “Ramsey-Catan teaches an attempted transaction approved without providing a notification message when the attempted transaction does not satisfy a threshold-based rule.” Applicants disagree.

As a threshold issue, the Office has not made a prima facie argument that the Brown reference and the Ramsey-Catan reference (and, further the Gopinathan reference) are combinable for purposes of showing obviousness under 35 U.S.C. §103. Further, even if the teachings are combined, there is no showing that the combination would lead to the claimed invention of claim 22.

Brown is directed to the “detection of unauthorized account transactions” (see Brown at the title); Ramsey-Catan, on the other hand, is directed to a “TV shopping monitor and notification system” (see Ramsey-Catan at the title).

More particularly, the cited portions of Brown are directed to confirming whether a personal identification number (PIN) is input correctly and, if it was, providing information to the account holder regarding the transaction (the Office has cited to Brown at paragraph 0037.)

The Office has not pointed to any particular teaching of Ramsey-Catan to support the conclusion that Ramsey-Catan teaches an attempted transaction being approved without providing a notification message when the attempted transaction does not satisfy a threshold-based rule.

However, it is noteworthy that Ramsey-Catan is clearly directed to a system for tracking and control of transactions purchased through a television based shopping system where the various checks against pre-set limits are done by the television based shopping system before the transaction is even provided to a credit card or other payment card processor (see, e.g., Ramsey-Catan at paragraph 0027).

For this reason, there is no showing that a combination of the teachings of the cited combination of Brown and Ramsey-Catan discloses or suggests the particular combination of claim 22 would lead to the claimed invention. Rather, the teachings of Ramsey-Catan would suggest that the retailer or other entity seeking to sell a product or service to the payment card holder would have its own database of customers and their preset limits and the system would

check against that database before sending a transaction to be processed by a payment card processor.

Thus, Claim 5, 15 and 22 are allowable over the combination of Brown/Ramsey and are also allowable over the combination of Brown/Ramsey with Gopinathan.

Claims 7, 17 and 23 are Allowable

The Office has rejected claims 7, 17 and 23 under 35 U.S.C. §103(a) as obvious over Brown/Ramsey-Catan in view of Cheechio.

Without admitting that Brown, Ramsey-Catan and Cheechio are properly combinable in making this rejection, or that the teachings of Cheechio, if combined with Brown and Ramsey-Catan, would show the invention as claimed in claims 1 or 11, claims 7, 17 and 23 depend from Claims 1 and 11 and are allowable for reasons as discussed above in connection with those claims.

Claims 8 and 18 are Allowable

The Office has rejected claims 8 and 18 under 35 U.S.C. §103(a) as obvious over Brown/Ramsey-Catan in view of Taylor.

Without admitting that Brown, Ramsey-Catan and Taylor are properly combinable in making this rejection, or that the teachings of Taylor, if combined with Brown and Ramsey-Catan, would show the invention as claimed in claims 1 or 11, claims 8 and 18 depend from Claims 1 and 11, respectively, and are allowable for reasons as discussed above in connection with those claims.

Claim 21 is Allowable

The Office has rejected claim 21 under 35 U.S.C. §103(a) as obvious over Brown/Ramsey-Catan in view of Tubinis.

Without admitting that Brown, Ramsey-Catan and Tubinis are properly combinable in making this rejection, or that the teachings of Tubinis, if combined with Brown and Ramsey-Catan, would show the invention as claimed in claim 11, claim 21 depends from Claim 11 and is allowable for reasons as discussed above in connection with claim 11.

CONCLUSION

Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the cited portions of the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the objections and rejections, as well as an indication of the allowability of each of the pending claims.

Applicants believe there are other distinctions, not specifically pointed out in this response between the present invention, as claimed, and the cited references. No attempt, however, has been made to point out all differences between the claims and the cited references as the claims are believed to be allowable for the reasons discussed.


Any changes to the claims in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

6-23-2008
Date



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